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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,843	01/07/2002	James Samsoundar	31773-CIP1	3741
23589	7590	11/02/2005	EXAMINER	
HOVEY WILLIAMS LLP 2405 GRAND BLVD., SUITE 400 KANSAS CITY, MO 64108			LIN, JERRY	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/040,843

Applicant(s)

SAMSOONDAR, JAMES

Examiner

Jerry Lin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-18,20,22 and 29-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-18,20,22 and 29-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicants' arguments, filed August 16, 2005, have been fully considered and they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-18, 20, 22, and 29-40, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has responded to this rejection by stating that in claims 12 and 31, step iii) and step iv) are alternative steps, and not successive steps. However, wording of the instant claims do not clearly present step iii) and step iv) as alternative steps. For example, one interpretation of claim 12 is that the method for manipulating a fluid comprises steps i), ii), and iii) or comprises only step iv). Another interpretation of claim 12, as presented by the applicant, is that method for manipulating a fluid comprises steps i) and ii) and further comprises steps iii) or iv). Thus it is unclear that step iii) and step iv) are alternative steps to a process that also includes step i) and step ii). Since it is unclear, one interpretation of the instant claims may lead to a conflict with the "all"

Art Unit: 1631

aspiration limitation in part iii) and the "said fluid" limitation in part iv) as explained in the previous office action. This rejection is maintained from the previous office action.

For purposes of this office action, the Examiner will interpret instant claims 12 and 31 to mean step iii) and step iv) are alternative additional steps to the method comprising step i) and step ii).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 14, 16, 17, 20, 22, 29, 30, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjornson et al. (US 5,206,568) in view of Ebersol et al.

Regarding claims 12, 29 and 30, Bjornson et al. teach a method of aspirating a fluid into a reservoir (column 13, lines 13-30; column 21, lines 50-61; column 22, lines 31-46; column 5, lines 50-68); inserting a second dispensing tip in said sample reservoir and aspirating a portion or all of said fluid from said sample reservoir into said second dispensing tip (column 10, lines 1-44); or withdrawing a reagent into a second dispensing tip and dispensing the reagent through the first end of the sample reservoir to form a mixture (column 10, lines 1-44; column 22, lines 31-46; column 24, line 8-column 26, line 54).

Although Bjornson et al. teach his method is usable with other reservoirs, Bjornson does not specifically teach using a dispensing tip with a sealed second end defining a sample reservoir.

Regarding claims 12, 14, 29, and 30 Ebersole et al. teach method where a dispensing tip with a first and second end, wherein the second end is sealed with flame and defines a sample reservoir (column 24, line 64-column 25, line 18).

Regarding claims 16, 17, 20, 22 and 39, Bjornson et al. also teach wherein the steps are preformed by a chemistry analyzer apparatus (Abstract); where the steps are manually performed (column 1, lines 30 – 54); wherein the second dispensing tip is sized to reach the second end of the reservoir (column 35, lines 3-40); wherein the step of withdrawing is followed by removing the mixture into the second dispensing tip and dispensing the mixture into the reservoir which is repeated (column 35, lines 3-40).

It would have been obvious at the time the claimed invention was made to use the microtubes created by Ebersole et al. with the apparatus of Bjornson et al. to gain the advantage of gaining better control of smaller volumes. The microtubes created by Ebersole et al. offer the advantage of providing the user greater control over small volumes of fluid. Bjornson et al. teach an apparatus for conducting assays in multiple reaction chambers at once that is capable of using any type of fluid reservoir. Thus, one of ordinary skill in the art would use Bjornson et al.'s apparatus with Ebersole et al.'s microtubes to conduct multiple assays using small volumes of fluid. Thus one of ordinary skill in the art would have been motivated at the time the invention was made to use microtubes with Bjornson et al.'s apparatus.

This rejection was necessitated by amendment.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (571) 272-2561. The examiner can normally be reached on 6:30-5:00, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D. can be reached on (571) 272-0718. The fax phone

number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It

Art Unit: 1631

also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center at (800) 786-9199.

*Ardin H. Marschel* 10/29/05  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER

JL